

REMARKS

Claim Rejections

Claim 1 is rejected under 35 U.S.C. § 102(e) as being anticipated by Kraft (U.S. 6,411,822). Claim 2 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Kraft in view of Courtis et al. (JP411103338A). Claim 3 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Kraft in view of Stanley et al. (U.S. 4,266,102).

Drawings

Applicant proposes to amend Figure 3 as illustrated in red on the attached photocopy. In Figure 3, it is proposed to add reference number "36". No "new matter" has been added to the original disclosure by the proposed amendment to this figure. Approval of the proposed drawing change is respectfully requested.

Amendments to Specification

Applicant has amended the specification as noted above to correct reference numbers for the fixed line telephone circuit and the mobile phone. No "new matter" has been added to the original disclosure by the foregoing amendments to the specification.

New Claims

By this Amendment, Applicant has canceled claims 1-3 and has added new claims 4-5 to this application. It is believed that the new claims specifically set forth each element of Applicant's invention in full compliance with 35 U.S.C. § 112, and define subject matter that is patentably distinguishable over the cited prior art, taken individually or in combination.

The new claims are directed toward a telephone dialing apparatus for downloading a telephone directory from a mobile phone subscriber identity module (SIM) card comprising: a SIM card socket (11) connected to the mobile phone SIM card; a SIM card reader (12) connected to the SIM card socket and having communication protocols of the mobile phone SIM card, the SIM card reader reads

the telephone directory stored on the mobile phone SIM card; a memory unit (14) connected to the SIM card reader for storing the telephone directory read by the SIM card reader; a dialing unit (15) connected to the memory unit outputting dialing signals; a control unit (13) connected to the SIM card reader, the SIM card reader, the memory unit, the dialing unit; an information editing unit (18) connected to the control unit for editing the telephone directory stored in the memory unit; an alarm unit (17) connected to and displaying information from the control unit, the memory unit and the information editing unit, the alarm unit generates audible and visual alarms; and a human-machine interface (16) connected to and controlling the control unit, wherein the dialing unit is connected to a fixed line telephone circuit (T) receiving dialing signals from the dialing unit to dial a phone number from the telephone directory of the mobile phone SIM card.

In another embodiment the dialing unit is connected to an earphone circuit (3) that is connected to a mobile phone (A), the earphone circuit receiving dialing signals from the dialing unit to dial a phone number.

The primary reference to Kraft teaches a communication terminal that includes a mobile phone (1) having an SIM card (16), and SIM card holder (30), the processor (18) and memory (17a, 17b).

On page 3 of the outstanding Office Action, the Examiner admits that Kraft does not teach the “apparatus is linked to an ear phone circuit.” On page 3 of the outstanding Office Action, the Examiner admits that Kraft does not teach the “apparatus is linked to a fixed line telephone.”

Kraft does not teach the alarm unit generates audible and visual alarms; the dialing unit is connected to a fixed line telephone circuit receiving dialing signals from the dialing unit to dial a phone number from the telephone directory of the mobile phone SIM card; nor does Kraft teach the dialing unit is connected to an earphone circuit that is connected to a mobile phone, the earphone circuit receiving dialing signals from the dialing unit to dial a phone number.

It is axiomatic in U.S. patent law that, in order for a reference to anticipate a claimed structure, it must clearly disclose each and every feature of the claimed structure. Applicant submits that it is abundantly clear, as discussed above, that Kraft do not disclose each and every feature of Applicant's new claims and,

therefore, could not possibly anticipate these claims under 35 U.S.C. § 102. Absent a specific showing of these features, Kraft cannot be said to anticipate any of Applicant's new claims under 35 U.S.C. § 102.

The secondary reference to Courtis et al. teaches a wireless telephone including a head set (40) with a button (33) and a microphone (21) connected by a cord (22) to a mobile phone (30).

Courtis et al. do not teach a SIM card socket connected to the mobile phone SIM card; a SIM card reader connected to the SIM card socket and having communication protocols of the mobile phone SIM card, the SIM card reader reads the telephone directory stored on the mobile phone SIM card; a control unit connected to the SIM card reader, the SIM card reader, the memory unit, the dialing unit; an information editing unit connected to the control unit for editing the telephone directory stored in the memory unit; an alarm unit connected to and displaying information from the control unit, the memory unit and the information editing unit; the alarm unit generates audible and visual alarms; a human-machine interface connected to and controlling the control unit; the dialing unit is connected to a fixed line telephone circuit receiving dialing signals from the dialing unit to dial a phone number from the telephone directory of the mobile phone SIM card; nor do Courtis et al. teach the dialing unit is connected to an earphone circuit that is connected to a mobile phone, the earphone circuit receiving dialing signals from the dialing unit to dial a phone number.

The secondary reference to Stanley et al. discloses an automatic dialing device for storing and dialing telephone numbers from business cards and credit cards.

Stanley et al. do not teach a SIM card socket connected to the mobile phone SIM card; a SIM card reader connected to the SIM card socket and having communication protocols of the mobile phone SIM card, the SIM card reader reads the telephone directory stored on the mobile phone SIM card; a control unit connected to the SIM card reader, the SIM card reader, the memory unit, the dialing unit; an information editing unit connected to the control unit for editing the telephone directory stored in the memory unit; the alarm unit generates audible and visual alarms; the dialing unit is connected to a fixed line telephone circuit receiving dialing

signals from the dialing unit to dial a phone number from the telephone directory of the mobile phone SIM card; nor do Stanley et al. teach the dialing unit is connected to an earphone circuit that is connected to a mobile phone, the earphone circuit receiving dialing signals from the dialing unit to dial a phone number.

Even if the teachings of Kraft, Courtis et al., and Stanley et al. were combined, as suggested by the Examiner, the resultant combination does not suggest: the alarm unit generates audible and visual alarms; the dialing unit is connected to a fixed line telephone circuit receiving dialing signals from the dialing unit to dial a phone number from the telephone directory of the mobile phone SIM card; nor does the combination suggest the dialing unit is connected to an earphone circuit that is connected to a mobile phone, the earphone circuit receiving dialing signals from the dialing unit to dial a phone number.

It is a basic principle of U.S. patent law that it is improper to arbitrarily pick and choose prior art patents and combine selected portions of the selected patents on the basis of Applicant's disclosure to create a hypothetical combination which allegedly renders a claim obvious, unless there is some direction in the selected prior art patents to combine the selected teachings in a manner so as to negate the patentability of the claimed subject matter. This principle was enunciated over 40 years ago by the Court of Customs and Patent Appeals in In re Rothermel and Waddell, 125 USPQ 328 (CCPA 1960) wherein the court stated, at page 331:

The examiner and the board in rejecting the appealed claims did so by what appears to us to be a piecemeal reconstruction of the prior art patents in the light of appellants' disclosure. ... It is easy now to attribute to this prior art the knowledge which was first made available by appellants and then to assume that it would have been obvious to one having the ordinary skill in the art to make these suggested reconstructions. While such a reconstruction of the art may be an alluring way to rationalize a rejection of the claims, it is not the type of rejection which the statute authorizes.

The same conclusion was later reached by the Court of Appeals for the Federal Circuit in Orthopedic Equipment Company Inc. v. United States, 217 USPQ 193 (Fed.Cir. 1983). In that decision, the court stated, at page 199:

As has been previously explained, the available art shows each of the elements of the claims in suit. Armed with this information, would it then be non-obvious to this person of ordinary skill in the art to coordinate these elements in the same manner as the claims in suit? The difficulty which attaches to all honest attempts to answer this question can be attributed to the strong temptation to rely on hindsight while undertaking this evaluation. It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. Monday morning quarterbacking is quite improper when resolving the question of non-obviousness in a court of law.

In In re Geiger, 2 USPQ2d, 1276 (Fed.Cir. 1987) the court stated, at page 1278:

We agree with appellant that the PTO has failed to establish a *prima facie* case of obviousness. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination.

Applicant submits that there is not the slightest suggestion in either Kraft, Courtis et al., or Stanley et al. that their respective teachings may be combined as suggested by the Examiner. Case law is clear that, absent any such teaching or suggestion in the prior art, such a combination cannot be made under 35 U.S.C. § 103.

Neither Kraft, Courtis et al., nor Stanley et al. disclose, or suggest a modification of their specifically disclosed structures that would lead one having ordinary skill in the art to arrive at Applicant's claimed structure. Applicant hereby respectfully submits that no combination of the cited prior art renders obvious Applicant's new claims.

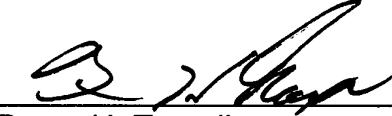
Summary

In view of the foregoing amendments and remarks, Applicant submits that this application is now in condition for allowance and such action is respectfully requested. Should any points remain in issue, which the Examiner feels could best be resolved by either a personal or a telephone interview, it is urged that Applicant's local attorney be contacted at the exchange listed below.

Respectfully submitted,

Date: August 24, 2004

By:


Bruce H. Troxell
Reg. No. 26,592

TROXELL LAW OFFICE PLLC
5205 Leesburg Pike, Suite 1404
Falls Church, Virginia 22041
Telephone: 703 575-2711
Telefax: 703 575-2707